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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,859	02/01/2000	Stephen R. Beaton	VTN-0458	4043

7590

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EXAMINER

FIDEI, DAVID

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 07/29/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/494,859

Applicant(s)

BEATON ET AL.

Examiner

David T. Fidei

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 36-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 22.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***CLAIM CONSTRUCTION***

1. In analyzing applicant's invention as set out in the pending claims, the examiner sets forth the following to aid in understanding the application of the prior art herein. Claims are to be given their broadest reasonable during prosecution, see *In re Priest*, 582 F.2d 33, 37 USPQ 11, 15 (CCPA 1978), and limitations from the specification will not be read into the claims, see, e.g. *In re Prater*, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969). Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997), see MPEP 2106.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 17, 18, 39 and 40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over. Lupi (Patent no. 5,755,462) in view of Foote et al (Patent no. 6,036,231). Lupi discloses a packaging for housing at least one prescription product manufactured by a manufacturer and prescribed by a doctor on behalf of the prescriptions manufacturer. Customized and non-customized graphics are provided by the manufacturer including printed material related to the medication, and ample space for printed promotional indicia on behalf of the prescription manufacturer are also provided, see the abstract.

The customized graphics are provided on at least some surface area of the packaging, the customized graphics being 16a "preprinted physician's information for enhanced prestige and identification afforded to the prescribing medical practitioner", column 2, lines 62 & 63.

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Hence Lupi discloses the subject matter as claimed where the preprinted physician's information is taken to correspond to the customized graphics consisting essentially of print produced by at least one printer.

To the extent that the corresponding customized graphics of Lupi is not produced by a printer, the rejection is applied in the alternative, in that such a method of providing preprinted information would have been obvious to one of ordinary skill in this art. Foote discloses a label and record system for medication where a printer 26 is used to print a label 16. It would have been obvious to one of ordinary skill in the art to employ printer to provide the physician's customized information of Lupi as taught by Foote, for the reason that a printer is a well known expedient manner of printing information.

As to claim 2, it is unclear how the specified time which customized graphics are indicated materially affects the subject matter of claim 1. It would appear inherent and necessarily required to specify the graphics any time prior to shipment. To specify the customized graphics at the time of order, or anytime prior to shipment would appear to be a matter of design dependent upon when the manufacturer decides to be apprised of the required information.

As to claim 3, the graphics identifies a person's name, address and date of the person for whom the medication is for, the pack does not identify the prescription, claim 4.

With respect to claims 17, 18 and 40, to use any form of means for conveying information to "enhanced prestige and identification afforded to the prescribing medical practitioner" such as alphanumeric characters, pictures, photographs, trademarks, logo's or any other known form of communication would have been an obvious matter of design choice dependent upon the style and type of information one desires to convey.

With respect to claim 39, Lupi does not disclose when the customized and non-customized graphics are added to the package, but it would appear to be obvious to add the graphics at anytime prior to shipment or distribution to the physician.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 7-16 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over European document EP 0 734 957 A1 in view of Lupi (Patent no. 5,755,462). European document EP 0 734 957 A1 to Johnson & Johnson discloses a packaging for at a prescription product, such as a contact lens, comprising a primary package and a secondary package as shown in figures 1-8. The difference between the claimed subject matter and European document EP 0 734 957 A1 to Johnson & Johnson resides in customized graphics present that promotes a return visit to the doctor or advertises for the doctor. EP 0 734 957 A1 discloses that inner containers 10, 12 are provided with "specific orders from a prospective user", and cartons "may be customized prior to filling", col. 8, lines 41-43.

Lupi discloses a packaging for housing at least one prescription product manufactured by a manufacturer and prescribed by a doctor on behalf of the prescriptions manufacturer. Customized and non-customized graphics are provided by the manufacturer including printed material related to the medication, and ample space for printed promotional indicia on behalf of the prescription manufacturer are also provided, see the abstract. The customized graphics are provided on at least some surface area of the packaging, the customized graphics being 16a "preprinted physician's information for enhanced prestige and identification afforded to the prescribing medical practitioner", column 2, lines 62 & 63.

It would have been obvious to one of ordinary skill in the art to modify the packaging arrangement of Johnson & Johnson, either the primary or secondary packaging, by providing customized graphics as taught by Lupi, in order to provide "enhanced prestige and identification afforded to the prescribing medical practitioner". To the extent that the corresponding customized graphics of Lupi is not produced by a printer, it would have been within the level of

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ordinary skill to employ printer, for the reason that a printer is a well known expedient manner of printing information.

As to claim 11, providing contact lenses lidstocks comprised of labels is disclosed in figure 2 of European document EP 0 734 957.

With respect to claims 36 and 37 label identifying means, such as bar code, is customary and the graphics on European document EP 0 734 957 A1 don not identify the prescription, claim 38.

**REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION**

6. "In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to every ground of objection and rejection in this Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. The reply must be reduced to writing (emphasis added)", 37 CFR 1.111 (b) *in part*, see M.P.E.P. 714.02.

Pointing out specific distinctions means clearly indicating in the written response what features/elements or distinctions have been added to the claim/claims, where support is found in the specification for such recitations and how these features are not shown, taught, obvious or inherent in the prior art.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b), M.P.E.P. 714.02.

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The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)" (emphasis mine), see MPEP 706.07(a).

**Conclusion**

7. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning the MERITS of this examination from the examiner should be directed to David T. Fidei whose telephone number is (703) 308-1220. The examiner can normally be reached on Monday - Friday 6:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.


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Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8497
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
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David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
July 28, 2003